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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/915,884 07/20/92 MATSUI

1 40295/110

EXAMINER

MARSCHEL, A

18N1/0629

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ART UNIT

PAPER NUMBER

28

1807

DATE MAILED:

06/29/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7-20-92
8-27-92
10-8-92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449. (1 sheet)
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-16 and 18-22 are pending in the application.
Of the above, claims 8-15 are withdrawn from consideration.
- ☒ Claims 17 has been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 1-7, 16, and 18-22 are rejected.
- ☐ Claims are objected to.
- ☒ Claims 1-16 and 18-22 are subject to restriction or election requirement.
- ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
- ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Applicants' arguments filed 7/20/92 and 8/27/92 and the Information Disclosure Statement filed 10/8/92 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

In the Preliminary Amendment filed 8/27/92, it is stated that applicants wish to substitute the attached abstract for the originally filed abstract. Unfortunately, there was no abstract attached and therefore the abstract remains unchanged from that originally filed.

If applicant desires priority under 35 U.S.C. § 120 based upon a parent application, specific reference to the parent application must be made in the instant application. It is noted that this appears as the first sentence of the specification following the title. Status of the parent application (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "Patent No." should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification as originally filed fails

to provide support for the invention as is now claimed.

Claim 1, lines 4-5, contains the phrase "and AB heterodimer forms of platelet derived growth factor and also binds the BB homodimer with high affinity" which has not been found in the disclosure as filed. Therefore this phrase that combines these characteristics is NEW MATTER.

Claims 1 and 4-6 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim 20 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the DNA of claim 21 because in order to enable the differential hybridization cited in claim 20 the sequence information for both of the cited receptors must be instantly enabled, which is not the case. See M.P.E.P. §§ 706.03(n) and 706.03(z).

Claims 1-7, 16 and 18-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, and similarly in other claims, a "sequence" is cited as if it were a composition. This is vague and indefinite in that a sequence is a characteristic of a polynucleotide or protein but is not in itself a composition. Clarification is requested as to whether applicants wish to claim a composition or a characteristic.

Claims 2 and 3 specifically cite the phrase "an allelic

variations thereof" which is vague and indefinite in that this is not defined in the specification as to its metes and bounds. Do applicants wish to claim both active and inactive allelic forms? How much variation is within the scope of the claims? Since the growth factor receptor has several activities regarding molecules bound, do applicants mean allelic variations that only affect some of these activities? Clarification including support in the specification is requested.

Claims 1-7, 16 and 18-22 are allowable over the prior art of record because the Figure 3 depicted DNA is neither taught nor suggested by the prior art of record.

No claim is allowed.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CM1 Fax Center number is (703) 308-4227 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

AM

A. MARSCHEL:am

June 28, 1993

M. Park

MARGARET MOSKOWITZ PARK
SUPERVISORY PATENT EXAMINER
GROUP 180